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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,829	01/19/2001	Morris D. Ho	WEB1P003	9919
22434	7590	12/23/2004	EXAMINER	
BEYER WEAVER & THOMAS LLP			STOCK JR, GORDON J	
P.O. BOX 70250			ART UNIT	
OAKLAND, CA 94612-0250			PAPER NUMBER	
			2877	

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/765,829

Applicant(s)

HO ET AL.

Examiner

Gordon J Stock

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-25,27-38,40-65,67 and 68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8,9,21,22,24,27-31,35-38,42,43,46-48,53,54,59,61 and 67 is/are allowed.
- 6) ☒ Claim(s) 6,11-20,32,40,41,49-51,56,57 and 62-64 is/are rejected.
- 7) ☒ Claim(s) 1,5,7,10,23,25,33,34,44,45,52,55,58,60,65 and 68 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. **Claim 1** is objected to for the following: “the number” of line 3, “the roll map” of line 5, “said inspection system” of lines 8-9, “the predetermined range” of line 12, “the accuracy” of line 16 lack antecedent basis. In addition, on line 15 “components the web” should read – components of the web--. Corrections required.
2. **Claim 5** is objected to for the following: “self-diagnostic” needs to be capitalized. Correction required.
3. **Claim 6** is objected to for the following: “the calibration” lacks antecedent basis. Correction is required.
4. **Claim 7** is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. **Claim 7** is a restatement of line 10 of **claim 1**. In addition, “self-diagnostic” needs to be capitalized. Corrections required.
5. **Claim 10** is objected to for the following: “the location” of line 9, “the accuracy” of line 17 lack antecedent basis. And on line 8 “of the one or more detectable defects” should read –of the at least one of the one or more detectable defects--. Corrections required.
6. **Claims 19-20** are objected to for the following: “inspection parameters” should read – inspection set-up parameters--. Correction required.
7. **Claim 23** is objected to for the following: “the certification report” lacks antecedent basis. Correction is required.

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8. **Claim 25** is objected to for the following: “the measured defect data” lacks antecedent basis. Correction required.
9. **Claim 32** is objected to for the following: “the location” of line 3 lacks antecedent basis. Correction required.
10. **Claim 33** is objected to for the following: “the one or more defects” should read –the at least one of the one or more defects--. Correction required.
11. **Claim 34** is objected to for the following: “the roll map” of line 7 lacks antecedent basis; “the accuracy” of line 13 lacks antecedent basis. Corrections required.
12. **Claim 41** is objected to for the following: “said system inspection parameters” lacks antecedent basis. Correction is required.
13. **Claim 44** is objected to for the following: “the measured defect data” lacks antecedent basis. Correction is required.
14. **Claim 45** is objected to for the following: “the location” of line 2 lacks antecedent basis. Correction is required.
15. **Claim 49** is objected to for the following: “the number” of line 3 lacks antecedent basis; “the predetermined range” of line 12 lacks antecedent basis; “the accuracy” of line 17 lacks antecedent basis. Correction is required.
16. **Claim 50** is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. **Claim 50** is a restatement of line 10 of **claim 49**. In addition, “self-diagnostic” needs to be capitalized. Corrections required.

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17. **Claim 52** is objected to for the following: on line 8 “the one or more detectable defects” should read –at least one of the one or more detectable defects--; “the location” of line 9 lacks antecedent basis; “the accuracy” of line 21 lacks antecedent basis. Corrections required.

18. **Claim 55** is objected to for the following: on line 8 “the one or more detectable defects” should read –at least one of the one or more detectable defects--; “the location” of line 9 lacks antecedent basis; “the accuracy” of line 22 lacks antecedent basis. Corrections required.

19. **Claim 58** is objected to for the following: “the roll map” on line 7 lacks antecedent basis; “the accuracy” on line 15 lacks antecedent basis. Correction is required.

20. **Claim 60** is objected to for the following: “the measured defect data” lacks antecedent basis. Correction required.

21. **Claim 62** is objected to for the following: “the roll map” of 7 lacks antecedent basis; “the accuracy” of line 17 lacks antecedent basis. Correction required.

22. **Claim 63** is objected to for the following: “the measured defect data” lacks antecedent basis. Correction required.

23. **Claim 65** is objected to for the following: “the roll map” of line 6 lacks antecedent basis; “the accuracy” of line 10 lacks antecedent basis; “a roll map” of line 11 should read –the roll map--; “the location” of line 14 lacks antecedent basis; “material create” of line 18 should read –material to create--; “the detected one or more defects” of line 19 should read –the detected at least one or more defects--. Corrections required.

24. **Claim 68** is objected to for the following: “the location” of line 6 lacks antecedent basis; “the certification” of line 12 lacks antecedent basis. Correction required.

Claim Rejections - 35 USC § 112

25. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

26. **Claim 6, 11-20, 32, 40-41, 49-51, 56, 57, 62-64** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

27. **Claim 6** recites the limitation “said certification data” which renders the claim indefinite, for it is unclear as to what certification data is being referred: applied or standardized certification data or both from **claim 1**.

28. **Claim 11** recites the limitation “said certification data” which renders the claim indefinite, for it is unclear as to what certification data is being referred: actual or predetermined certification data or both from **claim 10**. **Claims 12-17** are rejected for being dependent upon a rejected base claim.

29. **Claim 18** recites the limitation “said certification data” which renders the claim indefinite, for it is unclear as to what certification data is being referred: actual or predetermined certification data or both from **claim 10**. In addition, the term “they” of line 5 is indefinite, for it is not clear what ‘they’ refers. Examiner suggests having “they” read –the inspection set-up parameters—for clarification. **Claims 19-20** are rejected for being dependent upon a rejected base claim.

30. **Claim 32** recites the phrase “the first inspection to the placed along the web material to the determined the location of the at least one detected defect” which is grammatically unclear rendering the claim indefinite.

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31. **Claim 40** recites the term “they” of line 4 which is indefinite, for it is not entirely clear what ‘they’ refers. Examiner suggests having “they” read –the inspection set-up parameters-for clarification. **Claim 41** is rejected for being dependent upon a rejected base claim.

32. **Claim 49** recites the term “said certification data” of line 13 which renders the claim indefinite, for it is unclear as to what certification data is being referred: applied or standardized certification data or both. **Claims 50-51** are rejected for being dependent upon a rejected base claim.

33. **Claim 56** recites the term “said certification data” which renders the claim indefinite, for it is unclear as to what certification data is being referred: actual or predetermined certification data or both from **claim 55**. **Claim 57** is rejected for being dependent upon a rejected base claim.

34. **Claim 62** recites the term “they” of line 15 which is indefinite, for it is not entirely clear what ‘they’ refers. Examiner suggests having “they” read –the product set-up parameters-for clarification. **Claim 63-64** are rejected for being dependent upon a rejected base claim.

Allowable Subject Matter

35. **Claims 8, 9, 21, 22, 24, 27-31, 35-38, 42, 43, 46-48, 53-54, 59, 61, and 67** are allowed.

Claims 1, 5, 7, 10, 23, 25, 33, 34, 44, 45, 52, 55, 58, 60, 65, and 68 would be allowable is rewritten to overcome the objections above.

Claims 6, 11-20, 32, 40-41, 49-51, 56, 57, 62-64 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

As to **claim 1**, the prior art of record, taken alone or in combination, fails to disclose or render obvious in a method for inspection of a roll of web material the particular steps of comparing certification data, performing a system integrity test, and certifying accuracy of the roll map data, in combination with the rest of the limitations of **claims 1, 5-9**.

As to **claim 10**, the prior art of record, taken alone or in combination, fails to disclose or render obvious in a method for certifying an inspection of a roll of web material the particular steps of measuring certification data, comparing the certification data, certifying the accuracy of the roll map and reinspecting the web material roll, in combination with the rest of the limitations of **claims 10-25, 27-33**.

As to **claim 34**, the prior art of record, taken alone or in combination, fails to disclose or render obvious in a web inspection certification system the particular diagnostic device and certifying device in combination with the rest of the limitations of **claims 34-38, 40-48**.

As to **claim 49**, the prior art of record, taken alone or in combination, fails to disclose or render obvious in a method for inspection of a roll of web material the particular steps measuring or retrieving certification data and comparing the certification data and certifying the accuracy of the roll map data, in combination with the rest of the limitations of **claims 49-51**.

As to **claim 52**, the prior art of record, taken alone or in combination, fails to disclose or render obvious in a method for certifying an inspection of a roll of web material the particular steps of measuring certification data, comparing the certification data, and certifying the accuracy of the roll map, in combination with the rest of the limitations of **claims 52-54**.

As to **claim 54**, the prior art of record, taken alone or in combination, fails to disclose or render obvious in a method for certifying an inspection of a roll of web material the particular

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steps of measuring certification data, comparing the certification data, and certifying the accuracy of the roll map, in combination with the rest of the limitations of **claims 54-57**.

As to **claim 58**, the prior art of record, taken alone or in combination, fails to disclose or render obvious in a web inspection certification system the particular diagnostic device and certifying device in combination with the rest of the limitations of **claims 58-61**.

As to **claim 62**, the prior art of record, taken alone or in combination, fails to disclose or render obvious in a web inspection certification system the particular diagnostic device and certifying device in combination with the rest of the limitations of **claims 62-64**.

As to **claim 65**, the prior art of record, taken alone or in combination, fails to disclose or render obvious in a web inspection certification system the particular diagnostic device and certifying device in combination with the rest of the limitations of **claims 65 and 67**.

As to **claim 68**, the prior art of record, taken alone or in combination, fails to disclose or render obvious in a method for certifying an inspection of a roll of web material the particular step of reinspecting the roll in an opposite direction to verify certification, in combination with the rest of the limitations of **claim 68**.

Response to Arguments

36. Applicant's arguments, see Remarks, filed October 18, 2004, with respect to the rejections of the claims under 35 U.S.C. 103(a) with the primary reference Van Tyne et al. (4,170,419) have been fully considered and are persuasive (specifically, that Van Tyne does not have a roll map comprising real-time visual images and that Van Tyne does not certify accuracy). The rejection under 35 U.S.C. 103(a) has been withdrawn. However, upon further

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consideration, Examiner has made new rejections under 35 U.S.C. 112 second paragraph and objections to the claims. See above. Examiner apologizes for the inconvenience.

Fax/Telephone Numbers

If the applicant wishes to send a fax dealing with either a proposed amendment or a discussion with a phone interview, then the fax should:

- 1) Contain either a statement "DRAFT" or "PROPOSED AMENDMENT" on the fax cover sheet; and
- 2) Should be unsigned by the attorney or agent.

This will ensure that it will not be entered into the case and will be forwarded to the examiner as quickly as possible.

Papers related to the application may be submitted to Group 2800 by Fax transmission. Papers should be faxed to Group 2800 via the PTO Fax machine located in Crystal Plaza 4. The form of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CP4 Fax Machine number is: (703) 872-9306

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gordon J. Stock whose telephone number is (571) 272-2431.

The examiner can normally be reached on Monday-Friday, 10:00 a.m. - 6:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley, Jr., can be reached at 571-272-2800 ext 77.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private Pair system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


gs

December 21, 2004


Zandra V. Smith
Primary Examiner
Art Unit 2877